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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 09/540,524	)	
Filed: March 31, 2000	)	Art Unit: 2862
Confirmation No.: 1816	)	Examiner: T. Fetzner
Inventors: J. Tamez-Peña et al	)	Docket No.: 000687.00138
Title: MAGNETIC RESONANCE IMAGING WITH RESOLUTION AND CONTRAST ENHANCEMENT	)	

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed December 12, 2001, the Applicants, through undersigned counsel, hereby elect invention I, claims 1, 2, 4-13, 28, 29 and 31-40, for further prosecution. This election is made *with traverse*.

The Office Action alleges that invention II has separate utility because of the specific equipment required by MRI. The Applicants respectfully disagree. The mere fact that invention I may use equipment other than that called for in invention II does not show that invention II has *separate* utility, as opposed to a particular embodiment of the utility of invention I. Therefore, the Applicants respectfully submit that the Office Action does not set forth a *prima facie* case that the subcombination has separate utility.

Also, it must be borne in mind that the relationship between combination and subcombination is different from the relation between genus and species. The Office Action seems to argue that inventions I and II have the former relationship simply because they have the

latter relationship. However, the two relationships are not the same and are not governed by the same principles.

Moreover, MPEP §803 provides as follows:

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application, the searches for inventions I and II would involve a substantial overlap. Therefore, the Applicants respectfully submit that any burden in the search and examination of the entire application, as opposed to invention I or II, would be *de minimis*. In particular, that burden is to be compared with the financial burden on the Applicants involved in filing and prosecuting a divisional application.

For the reasons set forth above, the Applicants respectfully submit that the present restriction requirement is improper and respectfully request that it be reconsidered and withdrawn.

The present traversal should not be construed as an admission that the two inventions are not patentably distinct. In the event that the restriction requirement is maintained, the Applicants reserve the full protection of 35 U.S.C. §121 against double-patenting rejections.

If any issues remain that can be overcome most easily through a telephone communication, the Examiner is invited to telephone the undersigned at the telephone number set forth below.

Please charge any shortage or credit any overpayment of fees to BLANK ROME COMISKY & MCCAULEY LLP, Deposit Account No. 23-2185 (000687.00138). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this Response or is insufficient to render this Response

timely, the Applicants hereby petition under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

José TAMEZ-PEÑA et al

By:
David J. Edmondson
Reg. No. 35,126

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BLANK ROME COMISKY & MCCAULEY LLP

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David J. Edmondson	(202) 530-7438	3022

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: J. Tamez-Pena et al.
Serial No.: 09/540,524
Filing Date: March 31, 2000
For: MAGNETIC RESONANCE IMAGING WITH RESOLUTION AND CONTRAST ENHANCEMENT

Please stamp to acknowledge receipt of the following:

-- ***Response to Restriction Requirement***

DJE:dfs
March 12, 2002

Action Due Due Date

Atty Dkt. No.: 000687.00138
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